



TP

Docket No.: APA-0216
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hideki MORITA et al.

Application No.: 10/507,325

Confirmation No.: 2850

Filed: September 10, 2004

Art Unit: 1731

For: METHOD AND APPARATUS FOR
PROCESSING BRITTLE MATERIAL

Examiner: J. L. Lazorcik

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed September 13, 2007 (Paper No. 20070907), Applicant hereby provisionally elects with traverse Group I, claims 1-4, for continued examination.

Please note that Applicant reserves the right to rejoin the non-elected claim and/or file a divisional application covering the subject matter of the non-elected claim.

The Examiner has required a restriction under 35 U.S.C. §§ 121 and 372, and has alleged that the application contains inventions which are not linked so as to form a single general inventive concept under PCT Rule 13.1. Applicant respectfully disagrees, and therefore has traversed this restriction requirement. Applicant requests that the Examiner reconsiders this restriction requirement in view of the following remarks.

This application is a National Phase of a PCT application under 35 U.S.C. § 371, and is not an application filed under 35 USC § 111(a). MPEP § 1893(d) points out that with respect to national stage applications filed under 35 USC § 371, restriction practice under 35 USC § 121 is

inapplicable. Rather, Unity of Invention practice under PCT Rule 13 and 37 CFR § 1.475 applies. Accordingly, Restriction Requirements are governed under the Unity of Invention standards, and the Examiner must clearly specify why the claims directed to different groups of inventions lack a common special technical feature. Namely, Unity of Invention exists when claims are directed to a common special technical feature. This is discussed in detail in Chapter 1800 of the MPEP. Examples concerning Unity of Invention are given in the Annex to the MPEP, specifically Part 2 of Annex B to the Administrative Instructions under the PCT.

It appears that the Examiner has issued the Restriction Requirement on the basis that the method of claims 1-4 and the apparatus of claim 5 lack a distinct technical feature over the teaching of Lee et al. (U.S. Patent No. 5,443,315). However, Applicant notes that Group II, claim 5, is directed to an apparatus for performing the method of Group I. From this point of view, Applicant wishes to note that both Groups I and II of the present invention is distinguished from Lee et al. in that "a wavelength of light having a preset absorptance is selected, based on an actual absorptance data of a sample of a material that is the same as the brittle material to be processed and also based on a calculated value of absorptance that is calculated using a thickness of a sample."

In addition, Applicant notes that the specification does not provide any reason why actual absorptance is measured with use of a sample which has a different thickness than the brittle material to be processed (for example, a fraction of the brittle material) for the purpose of selecting the wavelength.

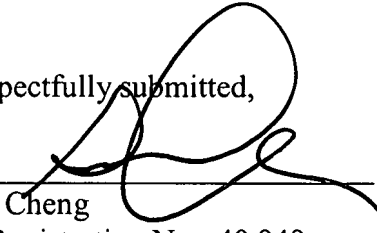
Applicants also hereby traverse the Restriction Requirement for the claims of Groups I and II since the examination of the claims of Group I (claims 1-4) and II (claim 5) poses no undue burden on the Examiner. Under §803 of the Manual of Patent Examining Procedure, if the search and examination of an entire application can be made without serious burden, the Examiner **must examine it on the merits, even though it includes claims to independent or distinct inventions.** For the reasons noted above, Applicant submits that the subject matter of the claims of Groups I and II is sufficiently related that a thorough search for the subject matter of any one claim within Group I and II would encompass a search for the subject matter of the remaining claims of Groups I and II. This is evidenced by the International Search Report which, in fact, searched the claims of all the Groups together.

It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office especially since the limitations of the claims of elected Group I are also present in the non-elected claim of Groups II.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. APA-0216 from which the undersigned is authorized to draw.

Dated: October 15, 2007

Respectfully submitted,

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